

REMARKS

Status of the claims

Originally filed claims 1, 11, 18-20, 22, and new claims 24-39 will be pending upon entry of this amendment.

Claims 2-10, 12-17, 21, and 23 have been canceled in favor of new claims 24-39 to expand the embodiments of the elected subject matter of Group III (antibodies). Applicants submit that the subject matter of new claims 24-39 falls within the scope of Group III, as defined by the Examiner in the Office Action mailed March 1, 2004.

Support for new claims 24-39 is found in the specification and claims as originally filed. More particularly, support for new claims 24-27 is found, for example, in the specification at paragraphs [0080], [0082], and [0118]. Support for new claim 28 is found, for example, in paragraph [0133]. Support for new claim 29 is found, for example, in paragraph [0126]. Support for new claim 30 is found, for example, in paragraph [0127]. Support for new claim 31 is found, for example, in paragraph [0132]. Support for new claim 32 is found, for example, in paragraph [0124]. Support for new claim 33 is found, for example, in paragraph [0161]. Support for new claims 34-35 is found, for example, in paragraphs [0056] and [0641]. Support for new claims 36-37 is found, for example, in paragraphs [0127]-[0129]. Support for new claims 38-39 is found, for example, in paragraph [0123] and Example 23 (paragraphs [0640]-[0644]). Thus, no new matter has been added.

Provisional Election

The Examiner has required an election under 35 U.S.C. § 121 of one of nine groups cast by the Examiner (Paper No. 02262004, mailed March 1, 2004). The Examiner contends that the individual groupings are distinct, each from each other.

Preliminarily, Applicants point out that new claims 24-39 fall within the ambit of Group III as cast by the Examiner.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group III, drawn to antibodies, represented by original claim 13 and new claims 24-39.

With respect to the Examiner's division of the invention into nine groups and the reasons stated therefore, Applicants respectfully traverse.

Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Further, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used in diagnostic and therapeutic indications.

In addition, searches of publications directed to polypeptides and methods of identifying binding partners of the polypeptides and antibodies against the polypeptides would clearly be overlapping, since many, if not most, publications which describe polypeptides also describe assays which use antibodies against the polypeptides and which could be used to evaluate binding partners of the polypeptides. Thus, a search of polypeptide claims would also provide the Examiner with art directed to assays for producing antibodies against the polypeptide and finding binding partners of the polypeptides.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, antibodies, methods of diagnosing and treating disease states, and methods of screening for binding partners would clearly be overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups I-IX together in the present application.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

CONCLUSION

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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